

REMARKS

Claims 1-45 are pending in the instant application. Claims 1-45 have been rejected by the Examiner. Claims 1 and 25-31 have been amended. Claims 3 and 4 have been canceled leaving claims 1, 2, and 5-45 for consideration upon entry of this amendment. The Applicants submit that claims 1, 2, and 5-45 are in condition for allowance and request reconsideration and withdrawal of the outstanding rejections. No new matter has been entered by this amendment. Claims 1, 25, and 31 have been amended to incorporate features recited in canceled claim 3. Claims 26-30 have been amended to incorporate features recited in claims 2, 5, 6, 9, and 10, respectively.

Claim Rejections Under 35 USC § 102

Claims 1-10, 17, 18, and 25-44 have been rejected under 35 U.S.C. 102(e) as being allegedly anticipated by U.S. Patent Publication No. 2003/0033288 to Shanahan et al. (hereinafter "Shanahan"). Claims 3 and 4 have been canceled. The Applicants respectfully traverse the outstanding rejections and submit that claims 1, 2, 5-10, 17, 18, and 25-44 are in condition for allowance.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Applicants submit that claims 1-10, 17, 18, and 25-44 are not anticipated by Shanahan because Shanahan does not teach or suggest each and every element recited in the Applicants' claims.

Claim 1 has been amended to recite, *inter alia*, "scanning an active document on a computer device operable for *identifying relevant keywords*; wherein ...said scanning an active document on a computer device operable for identifying relevant keywords is *performed by an intelligent search agent*, said method further including: *scanning text of an active page for said active document for at least one of: frequently appearing terms; frequently appearing phrases; and specific terms requested by said user; determining relevance of found terms or*

phrases resulting from said scanning, said determining relevance of found terms or phrases based upon rules prescribed by said intelligent agent.”

Shanahan does not teach or suggest scanning an active document for determining relevant key words as recited in claim 1. As recited in amended claim 1, determining relevant keywords for an active document is performed by scanning an active page of the active document for at least one of: frequently appearing terms (which the Examiner states may be found in paragraph 0307 and in Figure 28); frequently appearing phrases (which the Examiner states may be found in paragraph 0307 and in Figure 28); and specific terms requested by said user (which the Examiner states may be found in paragraphs 0294, 0295, 0298). The Applicants respectfully disagree with the Examiner's characterization of the teachings of Shanahan. The relevant portions of Shanahan relied upon by the Examiner, in fact, teach that a user may specify a limit to the number of recurring words that may be annotated (paragraph 0307) and does not involve performing a keyword relevancy determination as recited in Applicants' claim 1.

Shanahan goes on to state, “when a particular document service request 106 is invoked by the meta-document server 200, entities are searched in reference document(s) and/or database(s) ...for their frequency of occurrence. ***If outside the range of the predefined threshold values, then the entity identified in the document content is not annotated, thereby advantageously limiting document markup*** in a user specifiable and intelligible manner” (paragraph 0308). Thus, the search for frequency of occurrence of an entity within a document is provided for the purposes of enabling a user to set limits on the number of annotations. There is no relevancy determination made by the system as recited in Applicants' claim 1. Accordingly, the Applicants submit that claim 1 is not anticipated by Shanahan. Claims 25 and 31 have been amended in a manner substantially similar to that of claim 1. For at least the reasons advanced above with respect to claim 1, the Applicants submit that claims 25 and 31 are in condition for allowance. Claims 2, 5-10, 17, and 18 depend from what should be an allowable base claim. Claims 26-30 depend from what should be an allowable base claim. Claims 32-44 depend from what should be an allowable base claim. For at least these reasons, the Applicants submit that claims 1-10, 17, 18, and 25-44 are in condition for allowance. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Claim Rejections Under 35 USC § 103

Claims 11-16 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shanahan in view of U.S. Patent No. 6,192,381 issued to Stiegemeier et al. (hereinafter “Stiegemeier”). In addition, claims 19-22 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shanahan in view of U.S. Patent Publication No. 2003/0033252 to Rhodes. Further, claims 23, 24, and 45 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan in view of U.S. Patent Publication No. 2002/0065849 to Ferguson et al. (hereinafter “Ferguson”). Claims 11-16, 19-22, 23, and 24 depend from what is believed to be an allowable base claim (claim 1). Claim 45 depends from what is believed to be an allowable base claim (claim 31). For at least these reasons, the Applicants submit that claims 11-16, 19-24, and 45 are in condition for allowance and respectfully request reconsideration and withdrawal of the outstanding rejections.

CONCLUSION

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested. It is submitted that the foregoing amendments and remarks should render the case in condition for allowance.

Accordingly, as the cited references neither anticipate nor render obvious that which the applicant deems to be the invention, it is respectfully requested that claims 1, 2, and 5-45 be passed to issue.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 09-0458.

Respectfully submitted,

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